

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10015361-1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 7/20/05Signature Ardis SitarTyped or printed name Ardis Sitar

Application Number

10/086,908

Filed

02/28/2002

First Named Inventor

Will G. Fetherolf

Art Unit

2853

Examiner

Leonard S. Liang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Todd A. Rathe

☒ attorney or agent of record. 38,276
Registration number _____☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Todd A. Rathe
SignatureTodd A. Rathe
Typed or printed name

(414) 297-5710

Telephone number

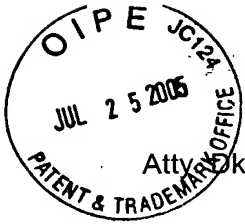
July 19, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Atty. Invt. No. 10015361-1

PRE-APPEAL BRIEF REQUEST FOR REVIEW

I. Rejection of Claims 29, 31-32, 34-40, 44, 54, 58-59 and 61 under 35 U.S.C. § 103 Based Upon Silverbrook '430 and Miyamota.

A. Claims 29, 58 and 59.

Neither Silverbrook '430 nor Miyamota, alone or in combination, disclose or suggest a media processing device or a method for processing media wherein the device is supported along a vertical surface and where media is fed through a media input along an external face of the device to an engine while the media is substantially vertical and is discharged from an external media output opposite the media input.

It would not be obvious to one of ordinary skill in the art to modify the mobile phone of Silverbrook '430 to additionally include the support disclosed by Miyamota since such a modification would destroy the intended function of the mobile phone of Miyamota or of the phone of Silverbrook '430 or would require a complete redesign of the support disclosed by Miyamota. (See MPEP 2143.01 THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE.)

In the present case, one of the intended purposes of the mobile phone of Silverbrook '430 is to provide an integral internal printer. In particular, Silverbrook '430 discloses a printer phone 1 in which print media 30 is fed through an entry slot 31 located on a side of printer phone 1. Miyamota discloses a portable telephone holder 1 which requires a pair of spaced belts 3 to retain the portable telephone 4 on holder 1. To modify printer phone 1 of Silverbrook '430 to additionally include telephone holder 1 would render printer phone 1 unsatisfactory for its intended purpose, printing. In particular, belts 3 of Miyamota would necessarily extend across slot 31 and interfere with or obstruct inputting of media into slot 31. Miyamota specifically discloses belts 3 as extending across a central portion of phone 1 across its keypad. To similarly position belts 3 across the keypad of Silverbrook '430 would result in belts 3 extending across and obstructing inputs slot 31 of Silverbrook '430.

Moreover, no teaching or suggestion exists for alternately modifying the location of belts 3 of Miyamota or omitting belts 3. Belts 3 of Miyamota are presumably located at their disclosed locations so as to not interfere with the display of the cell phone and so as to accommodate different cell phones having different lengths. To reposition the uppermost belt 3 would result in the belt 3 obstructing the display of the cell phone or may result in holder 1 not being able to accommodate differently sized cell phones. Moreover, as clear from drawing 3 of Miyamota, such belts are required to retain the cell phone in place and to prevent the cell

phone from falling off of legs 19. Thus, it would not be obvious to additionally modify the location of belts 3 or to omit belts 3. In short, the hypothetical combination of Silverbrook '430 and Miyamota as proposed in the Office Action would either render unsatisfactory the intended purpose of Silverbrook '430, printing, or would render unsatisfactory the intended purpose of Miyamota, securely retaining and supporting a cell phone. Accordingly, the rejection of Claims 29, 58 and 59 based upon the hypothetical combination of Silverbrook '430 and Miyamota would appear to be based solely upon impermissible hindsight reasoning. Applicant respectfully requests that the rejection of independent Claims 29, 58 and 59 be withdrawn.

B. Claim 31.

Neither Silverbrook '430 nor Miyamota, alone or in combination, disclose or suggest a media processing device wherein the device, when vertically oriented, has a height, a width and a depth, wherein the first face, along which the media input extends, and the second face, along which the media output extends, each define the width and the depth of the engine (i.e. a vertical or top-to-bottom media path). Neither Silverbrook '430 nor Miyamota disclose a media processing device in which the media input and the media output are located along external faces such that media moves along a substantially vertical or top to bottom path. In contrast, Miyamota fails to disclose any media input or media output. Silverbrook '430 merely discloses an entry slot 31 which facilitates side-to-side feeding of media, not vertical or top-to-bottom feeding of media.

The Office Action apparently acknowledges this deficiency of Silverbrook '430. In particular, in its rejection of the claims, the Office Action states:

NOTE: For purposes of this rejection figure 1 of Silverbrook, et al. will be viewed in an orientation 90° to the orientation shown in the figure. The reoriented figure 1 is shown below.

(Office Action, p. 2.) The Office Action fails to provide any support, motivation or suggestion for reorienting printer phone 1 of Silverbrook '430 other than the teachings found in Applicant's own disclosure. Such hindsight in view of Applicant's own disclosure is impermissible.

Moreover, as acknowledged in the Office Action, Silverbrook '430 still fails to disclose a support to couple the media processing engine of Silverbrook '430 to a vertical structure. Even assuming, arguendo, that it would be obvious to modify the printer phone 1 of Silverbrook '430 to additionally include the portable telephone holder 1 of Miyamota, the hypothetical combination would result in printer phone 1 of Silverbrook '430 being supported in the same orientation as shown in figure 1 of Silverbrook '430 and also in the same orientation as shown

in drawing 1 of Miyamota. In the orientation shown in figure 1 of both Silverbrook '430 and Miyamota, the first face along which the media input extends and the second face along which the media output extends would not define the width and depth of the engine. In the orientation illustrated in Figure 1 of both Silverbrook '430 and Miyamota, media would have to be fed through the cell phone along a horizontal or side-to-side path rather than a vertical top-to-bottom path.

Neither Silverbrook '430 nor Miyamota provide any motivation or suggestion for alternatively connecting portable telephone holder 1 of Miyamota to printer phone 1 of Silverbrook '430 in an alternative orientation other than that shown in drawing 1 of Miyamota. Neither Silverbrook '430 nor Miyamota provide any motivation or suggestion for reconfiguring portable telephone holder 1 to alternatively support a cell phone in a sideways horizontal orientation. In fact, one of ordinary skill in the art would seemingly be led away from such a modification in that both the screen or display of the cell phone and the keypad of the cell phone would also need to be retained in sideways orientation, making the reading of text on the display or the reading and entry of data through the keyboard of the cell phone difficult. Because the Office Action has failed to cite any motivation or suggestion for (1) reorienting printer phone 1 of Silverbrook 90° or (2) somehow reconfiguring the telephone holder of 1 of Miyamota to also support the printer phone 1 of Silverbrook '430 in the reoriented position, the rejection of Claim 31 based upon Silverbrook '430 and Miyamota appears to be improper as using Applicant's own disclosure as a blueprint for such a modification. Accordingly, Applicant respectfully requests that the rejection of Claim 31 be withdrawn for this additional reason.

C. Claim 61.

Neither Silverbrook '430 nor Miyamoto disclose or suggest the step of holding ejected media below the media output. Even assuming, arguendo, it would be obvious to modify the printer phone 1 of Silverbrook '430 to somehow include the telephone holder 1 of Miyamoto, the hypothetical combination would still fail to disclose any structure for facilitating the step of holding the ejected media below the media output. Even assuming, arguendo, that there was a suggestion to add a media holder to the hypothetical combination of Silverbrook '430 and Miyamoto, such a holder would not hold ejected media below the media output since media is discharged sideways from the printer phone 1 of Silverbrook '430. Accordingly, Applicant requests that the rejection of Claim 61 be withdrawn for this additional reason.

II. Rejection of Claims 45-46 based upon Silverbrook '430, Miyamota and Khormaeae.

Claim 45 depends from Claim 29 and recites that the media input is configured to receive media having a width of at least 8 inches.

The Office Action acknowledges that Silverbrook '430 fails to disclose a media input configured to receive media having a width of at least 8 inches. As a result, the Office Action attempts to additionally rely upon Khormae which indicates a common recording media may include standard 8.5 x 11 inch paper. However, the Office Action has failed to cite any motivation or suggestion for modifying entry slot 31 of the printer phone 1 of Silverbrook '430 to have a width of at least 8 inches. One of ordinary skill in the art would not be led to reconfigure printer phone 1 of Silverbrook such that its entry slot 31 has a dimension of at least 8 inches. The title itself of Silverbrook '430 recites that the phone is to "hand held" and "mobile". Enlarging printer phone 1 of Silverbrook '430 such that entry slot 31 has a dimension of at least 8 inches would destroy the intended function of printer phone as being a handheld mobile phone. Common sense dictates against such a hypothetical modification of Silverbrook '430. Accordingly, Applicant respectfully requests that the rejection of Claim 45 based upon Silverbrook '430, Miyamoto and Khormae be withdrawn. Claim 46 depends from Claim. Thus, Applicant respectfully requests that the rejection of Claim 46 also be withdrawn.

III. Rejection of Claims 48, 50-52, 55 and 60 based upon Silverbrook '430, Miyamoto and Silverbrook '349.

A. Claim 51

Neither Silverbrook '430, Miyamoto nor Silverbrook '349, alone or in combination, disclose or suggest the media processing device having a support configured to couple a media processing engine of the device to a vertical surface and a receiver which supports media in a tilted orientation directed away from the vertical surface. The Office Action acknowledges that Silverbrook '430 fails to disclose a receiver configured to support media in a tilted orientation away from the vertical surface. (Office Action, p. 9 discussing Claim 51.) As a result, the Office Action attempts to additionally rely upon Silverbrook '349 which discloses tray 619.

However, Silverbrook '430 discloses a handheld mobile phone with integral internal printer in which media is discharged along its side. Tray 619 of Silverbrook '349 is configured to receive media discharged from the bottom of a printer. The Office Action has failed to cite any teaching or suggestion in either Silverbrook '430 or Silverbrook '349 as to how tray 619 would somehow be mounted to printer phone of Silverbrook '430. Moreover the Office Action has failed to cite any motivation or suggestion for even further reconfiguring tray 619 so as to

support media in a tilted orientation away from a vertical surface. Thus, Applicant respectfully requests that the rejection of Claims 51 and 52 be withdrawn for this additional reason.

B. Claims 55 and 60.

As acknowledged in the Office Action, neither Silverbrook '430 nor Miyamoto disclose a media input configured to receive an individual sheet of media from a stack of media positioned proximate to the input. As a result, the Office Action attempts to additionally rely upon Silverbrook '349 and asserts that Silverbrook '349 discloses a media input configured to receive an individual sheet of media from a stack of media positioned proximate to the input. (Office Action, p. 10 – discussing Claim 55.)

However, media tray 607 disclosed by Silverbrook '349 is internally located within printer 601. Nowhere does Silverbrook '349 or Silverbrook '430 provide any teaching, suggestion or even motivation for somehow modifying the handheld mobile phone of Silverbrook '430 to include an internal print tray such as tray 607 of Silverbrook '349. Moreover, to somehow add an internal print tray 607 as disclosed by Silverbrook '349 would seemingly destroy the intended purpose of Silverbrook '430 to provide a handheld mobile phone. In addition, since the mobile phone of Silverbrook '430 feeds media in a horizontal side-to-side fashion, it would not be possible to add an internal printer tray such as printer tray 607 of Silverbrook '349 without requiring a complete reconstruction of the mobile phone of Silverbrook '430. In rejecting Claim 55, the Office Action appears to be selectively picking and choosing features from different patents and hodgepodging such features together using Applicant's own disclosure as a blueprint to read on the device recited in Claim 55. Thus, Applicant respectfully requests that the rejection of Claims 55 and 60 be withdrawn.

Respectfully submitted,

Date July 19, 2005

By Todd A. Rathe

FOLEY & LARDNER LLP
Customer Number: 22879
Telephone: (414) 297-5710
Facsimile: (414) 297-4900

Todd A. Rathe
Attorney for Applicant
Registration No. 38,276